

**REMARKS/ARGUMENTS**

Applicant respectfully requests reconsideration of this application in view of the foregoing amendments to the specification, claims and drawings, and the following remarks.

**Period for Response and Non-Final Designation**

Preliminarily, Applicant acknowledges with appreciation that the Examiner has acted on Applicant's *Request To Reset Or Restart Reply Period And To Correct Office Action To Be Non-Final*, dated January 21, 2003, by resetting the period for response and correcting the designation of the *Office Action* as non-final.

**Rejections Under 37 C.F.R. § 1.71**

In the *Office Action*, the Examiner asserted that the specification, as originally filed, did not provide support for the new matter on pages 3 and 4 of the *Amendment* dated August 30, 2002. The Examiner's assertion is not correct.

The specification as originally filed incorporated by reference the parent application Ser. No. 08/766,862. Both the words "glass, cardboard" on page 3 and the words "or more" on page 4 of the *Amendment* dated August 30, 2002, appear in the specification of the parent application, as originally filed. The Examiner is invited to inspect the specification of the parent application as originally filed to confirm this for himself. Alternatively, the Examiner's attention is invited to column 2, line 52, and column 3, line 16, of U.S. Patent No. 6,334,530, Applicant's patent which issued based on the parent application, where it can be seen that those words appear. OK

Accordingly, the above amendments adding the words "glass, cardboard" and "or more" were merely for the purpose of conforming the specification of the present application to the parent application, as was true for most of the other amendments to the specification in the *Amendment* dated August 30, 2002. As such, these words find support in the specification of this application, as originally filed.

The Examiner also asserted that Figure 5 and the corresponding portions of the specification relating to Figure 5 were not supported by the specification as filed and constitute new matter. The Examiner noted that the starting point of channel 20' does not have to be centered about knob 28', but may be located next to the knob, and the ending point of channel 20' "does not has [sic] to be near the edge of the organizer," referencing Figures 1-4. Applicant agrees with the Examiner that anyone of ordinary skill in the art would recognize the possibility of these alternative arrangements, and that there is no need to so limit the invention as described and claimed in the application.

Accordingly, Applicant has amended claim 16 so that it no longer specifies that the spiral channel is "centered about the knob," and Applicant has deleted Figure 5 and the corresponding portions of the specification as unnecessary to the invention as claimed. As now claimed, the starting point of the spiral channel may be centered about knob, or it may be located next to the knob, or otherwise, and the ending point of the channel may be near the edge of the organizer or not. Applicant has further broadened claim 16 by deleting reference to the recess in the lower surface of the body and incorporated that limitation in dependent claim 17.

#### **Rejections Under 35 U.S.C. § 112, 1st Paragraph**

The Examiner rejected claims 1-20 under 35 U.S.C. § 112, first paragraph, for the same reasons the examiner objected to the specification under 37 C.F.R. § 1.71.

As shown above, the Examiner was not correct as to the words "glass, cardboard" on page 3 and the words "or more" on page 4 of the *Amendment* dated August 30, 2002, and so he was similarly incorrect in rejecting claim 1-15 under section 112. As to claims 16-20, the amendment of claim 16 and the deletion of Figure 5 and the corresponding portions of the specification render this rejection moot.

### **Drawing Rejections**

The Examiner rejected the proposed drawing correction of adding Figure 5 as introducing new matter into the drawings. As noted, Applicant has deleted Figure 5, which renders this rejection moot.

### **Amendments to Correct The Specification and Drawings**

By this *Amendment*, Applicant has corrected a minor typographical error in paragraph [0015] and minor reference numeral errors in paragraphs [0016] and [0017]. No new matter has been introduced by these amendments.

Applicant also proposes to correct certain reference numeral errors in the Figures 3 and 4 of the drawings to better conform to the specification. Specifically, in Figure 3 Applicant has deleted one numeral 38 as inconsistent with the specification, extended the lead line on numeral 32 to make clear that it refers to the lower surface of the body, and added numerals 46 and 48. In Figure 4, Applicant has deleted numerals 30 and 32. No new matter has been introduced by these drawing corrections.

### **Claim Rejections Under 35 U.S.C. § 102**

In the *Office Action*, the Examiner has persisted in his rejection of claims 1, 2, 7-9 and 11 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent

No. 5,040,681 to Grusin. In doing so, the Examiner takes two positions with which Applicant respectfully disagrees.

First, the Examiner asserts that Grusin has at least two compartments 34 because there is a "knob (50)" [sic] in the middle of the recess 34. It is unclear what the examiner is referring to because reference numeral 50 in Grusin refers to an aperture in post member 44. "[E]ach post member 42, 44 and 46 is provided with an aperture 48, 50 and 52, respectively, in the upper surface of its distal end." (Col. 3, lines 46-48.)

Presumably the Examiner meant to refer to knob 30 formed on cover 18 of Grusin's desk organizer. According to the Examiner, this knob divides the recess 34 into separate compartments. The Examiner's position defies any common sense understanding of the word compartment. As used in Applicant's specification and claims, the word "compartment" has its ordinary meaning of "a separate division or section." There is nothing separate about the different portions of Grusin's recess 34; they are all part of one continuous channel surrounding the knob 30. Nonetheless, Applicant has added the redundant word "separate" to claim 1 to eliminate any possible basis for disagreement over this issue.

Second, the examiner asserts that "[t]he knob of Grusin is inherently capable of receiving at least one finger ring over the knob (Figures 1-5)." Presumably the examiner is referring to Figures 1-5 of Grusin, but Grusin's Figure 5 makes absolutely clear that Grusin is inherently incapable of receiving a finger ring over his knob 30. As explained in the patent,

In order to facilitate the manual separation of the various components 12, 14, 16 and 18 of the organizer container 10, each post member 42, 44 and 46 is provided with an aperture 48,

50 and 52, respectively, in the upper surface of its distal end. In addition, the knob 30 is provided with an aperture 54 positioned immediately above the aperture 52 of the third post member 46. Each aperture 48, 50, 52 and 54 is so dimensioned as to conveniently permit the insertion of a finger through the center of the knob 30, the third post member 46, the second post member 44, and the first post member 42.

(Col. 3, lines 44-55.) Grusin goes on to describe that "[e]ach aperture 48, 50, 52 and 54 defines a respective lip 56, 58, 60 and 62 which can be grasped by the user's finger tip, in a manner which will be described hereinafter." (*Id.*, lines 55-58.)

In order for the knob 30 to have an aperture 54 large enough to receive the person's finger and enough surrounding material to form a lip 62 for the person's finger to grasp, the outside dimensions of knob necessarily are much larger than a person's finger. (See Figure 5 of Grusin.) Indeed, in Figure 5 of Applicant's copy of Grusin, the knob is about one inch across and the finger is only about 3/8 inch. Of course, since the knob is approximately square, it is the diagonal measurement of the knob — about 1.4 inches — that must be considered if the knob is to receive a ring. This means that the knob is about 4 times larger than the person's finger insofar as the ability of the knob to receive a ring is concerned. Therefore, for a finger ring to fit over knob 30, the inside opening of the ring would have to be about 4 times larger than a person's finger. Applicant is unaware of any finger ring that satisfies the criteria that the opening in the ring is 4 times larger than the finger that the ring is supposed to go over. A ring fitted to a person's finger inherently would not even come close to fitting over knob 30 of Grusin.

Accordingly, the examiner has no basis for rejecting claims 1, 2, 7-9 or 11 as allegedly anticipated by Grusin.

**Claim Rejections Under 35 U.S.C. § 103**

The Examiner has also rejected claims 1-15 under 35 U.S.C. § 102(b) as allegedly anticipated by U.S. Patent No. 2,036,572 to Frost, or alternatively under 35 U.S.C. § 103 as allegedly obvious over Frost. In so doing, the Examiner mischaracterizes Frost's pie plate as an "organizer," Frost's central embossing 4 as a knob, Frost's embossings 5, 8, 12 as "walls," and Frost's unembossed annular portions 10, 11, 14, 15 as "compartments." The examiner further asserts without any support that Frost's central embossing 4 "is inherently capable of receiving at least one finger ring," when it is apparent from the drawing figures that the embossing 4 does not have sufficient height to receive a ring, and its diameter may be too large as well.

Applicant notes that if Frost's central embossing 4 were tall enough to receive a ring, all of the other embossings would have to be the same height in order for Frost's receptacle to serve its purpose as a pie plate. This would make the alleged "compartments" (*i.e.*, the unembossed portions) in Frost's pie plate relatively deep for a pie plate. In that event, Applicant believes that there would be a serious risk of the pie crust sinking down in the unembossed portions. As a result, the pie crust might well break apart, and the contents of the pie would then spill out between the bossings, producing an unwanted mess. On the other hand, if Frost's pie plate is constructed the way it was intended — with very shallow embossings — the only thing that the alleged "compartments" of Frost should ever hold are "pie vapors," to quote Frost.

Thus, Applicant respectfully disagrees with the Examiner's position. Nonetheless, Applicant has amended claims 1, 8 and 12 to recite that the knob protrudes upwardly from the body and extends above the upper surface of the body. No such feature is shown or suggested by Frost since the upper surface of Frost is defined by the embossings, and any such modification of Frost whereby the central embossing extended above the height of the other embossings would be completely at

odds with its intended use as a pie plate. In view of this amendment, the examiner should withdraw the rejection of claims 1-15 over Frost.

Conclusion

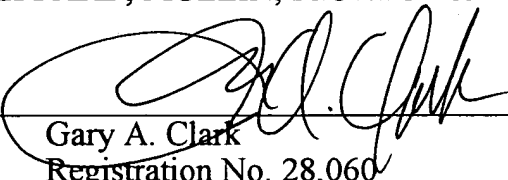
The foregoing amendments and remarks should place this application in condition for allowance. If any matters remain outstanding after consideration of this *Amendment* that the Examiner believes might be expedited by a telephone conference with Applicant's representative, he is respectfully requested to call the undersigned attorney at the number indicated below.

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Respectfully submitted,

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Attachment: Replacement Sheets of Drawings